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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,480	06/20/2003	Frank A. Skraly	MBX 027 DIV CON	6320
23579	7590	02/16/2006	EXAMINER	
PATREA L. PABST PABST PATENT GROUP LLP 400 COLONY SQUARE SUITE 1200 ATLANTA, GA 30361			COE, SUSAN D	
			ART UNIT	PAPER NUMBER
			1655	
DATE MAILED: 02/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/600,480	SKRALY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan D. Coe	1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,11,13 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/03; 7/04; 2/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 10, 11 and 13-19 are currently pending.

#### ***Election/Restrictions***

2. Applicant's election with traverse of 4-hydroxyvalerate for species A, bacteria for species B, polyhydroxyalkanoate synthase for species C, and poly (4-hydroxyvalerate) for species D in the reply filed on November 21, 2005 is acknowledged. The traversal is on the ground(s) that a search of all of the biological systems would not be burdensome. This is not found persuasive because a search of one of the systems would not necessarily overlap with a search of the other systems. In addition, a reference that anticipates one system would not necessarily anticipate another system; thus, it would be burdensome to examine all of the species claimed.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 14-17 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 21, 2005.
4. claims 10, 11, 13 and 18 are examined on the merits solely in regards to the elected species.

***Claim Objections***

5. Claim 10 is objected to because of the following informalities: in line 10, it appears that “of” is missing between “consisting” and “polyhydroxyalkanoate.” Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10, 11, 13, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Valentin et al. (Appl. Microbiol. Biotechnol. (1992), vol. 36, pp. 507-514).

Applicant’s claims are drawn to a method of using a bacteria expressing polyhydroxyalkanoate synthase (PHA synthase) to accumulate the polymer poly (4-hydroxyvalerate) from the substrate 4-hydroxyvalerate.

Valentin teaches using bacteria expressing PHA synthase to make polymers (see page 507). The bacteria accumulate polymers containing 4-hydroxyvalerate from a medium containing the substrate 4-hydroxyvalerate (see page 510). More than one 4-hydroxyvalerate is present in the accumulated polymer (see Table 2). Thus, the accumulated polymer is considered a poly (4-hydroxyvalerate) due to the presence of these numerous 4-hydroxyvalerates.

7. Claims 10, 11, 13, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (Appl. Microbiol. Biotechnol. (1995), vol. 42, pp. 901-909).

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Lee teaches using 4-hydroxyvalerate as a substrate for bacteria. The bacteria express PHA synthase. The polymer produced contains 4-hydroxyvalerate (see Table 3).

8. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.



Susan D. Coe  
Primary Examiner  
Art Unit 1655